

## AMENDMENT AFTER FINAL – GROUP 2141

Patent

### REMARKS

This paper is filed in response to the Examiner's Action mailed 05 April 2004.

The application was initially filed on 04 October 2000 with twenty-four claims. Upon the examination of the application on 01 December 2003, the Examiner rejected claims 1, 9, and 17 under 35 U.S.C. §102(a) as being anticipated by U.S. Patent 6,108,709 entitled SYSTEM FOR SENDING AN E-MAIL MESSAGE TO A FIRST TYPE OF TERMINAL BASED UPON CONTENT THEREOF AND SELECTED CONDITIONS AND SELECTIVELY FORWARDING IT TO A SECOND TYPE OF TERMINAL to Shinomura et al. (Shinomura '709). The Examiner further rejected claims 3-4, 11-12 and 19-20 under 35 U.S.C. §103(a) as being unpatentable over Shinomura '709 in view of U.S. Patent 6,438,583 B1 entitled SYSTEM AND METHOD FOR RE-ROUTING OF E-MAIL MESSAGES to McDowell et al. (McDowell '583). The Examiner further rejected claims 5-8, 13-16 and 21-24 under 35 U.S.C. §103(a) as being unpatentable over Shinomura '709 in view of U.S. Patent 6,163,809 entitled SYSTEM AND METHOD FOR PRESERVING DELIVERY STATUS NOTIFICATION WHEN MOVING FROM A NATIVE NETWORK TO A FOREIGN NETWORK to Buckley (Buckley '809). In response, Applicant amended the claims.

The Examiner considered the amendments and remarks on 05 April 2004 but the Examiner finally rejected claims 1-4, 9-12, 17-20 under 35 U.S.C. §103(a) as being unpatentable over Shinomura '709 in view of McDowell '583. The Examiner further rejected claims 5-8, 13-16, and 21-24 under 35 U.S.C. §103(a) as being unpatentable over Shinomura '709, McDowell '583 and further in view of Buckley '809. The Examiner also rejected claim 2 under 35 U.S.C. §112, second paragraph. In response Applicants amend the claims to put them in condition for allowance and/or in better condition for appeal, except for claims 14 and 22 which were previously amended, and claims 3, 16, and 23 which are cancelled without prejudice. Claims 1, 2, 4-15, 17-22, and 24 are pending.

In amending the claims, Applicant has not added new matter and further asserts that no new search is required because dependent claims have been incorporated into independent and intervening claims. The basis for the "self-rerouting" email message

is presented on page 13 of the originally filed specification in paragraph 49 and throughout the application. By inserting the extended alternate recipient parameter into the SMTP protocol of the email message itself, the message becomes self-rerouting. Applicant requests the Examiner to enter the amendments because they put the claims in condition for allowance.

The Rejection of claims 1-4, 9-12 and 17-20 under 35 U.S.C. §103(a)

The Examiner rejected claims 1-4, 9-12, and 17-20 under 35 U.S.C. §103(a) as obvious under Shinomura '709 in view of McDowell '583. The Examiner asserts that Shinomura '709 teaches a window containing a field "Alternate Name" for the sender to designate the terminal name, which specifies a user and other information that acts as an alternate receiver of an email message to be used in case the mail system cannot deliver the message to the original recipient. Hence, the Examiner asserts that, "Shinomura does teach an embedded 'Alternate Recipient' parameter in the GUI." The Examiner admits that Shinomura '709 does not explicitly teach specifying the alternative recipient by the addition of an ARCPT (Alternate Recipient) parameter in the SMTP protocol. That teaching, the Examiner proffers, is by McDowell '583 that teaches rerouting email sent to a prior address to the new address of an intended recipient through the SMTP implementation via software or hardware, i.e., by additional parameter in the SMTP protocol.

Shinomura '709 teaches a method and the interface for a user of a graphical user interface of an email application, such as Lotus Notes, Eudora, Outlook Express, to enter several alternative addresses whereby the alternative addresses are different receiving terminals, such as a PHS service device or a pager device or a cellular phone, etc. After a time-out period, if the email has not been delivered to the original email address, the sender then forwards the message to another email address at a different receiving terminal and so on. Shinomura '709 is based on an email application installed on a client from which a user sends email. Shinomura '709 does not resend to an alternative different receiving terminal unless and until a predetermined condition

exists and the only condition presented by Shinomura '709 is a predetermined period of time, i.e., if the email was not received by a first email address within a predetermined period of time, the sender's client resend the message to a different address in its address book. Shinomura '709 further requires the sender's client to resend the message each time, i.e., Shinomura '709 is an application program interface that will read an alternative email address in its address book and send the message to a different email address in a different receiving terminal and will truncate the email if necessary to accommodate the different receiving terminal when an original message has not been delivered within a time-out period programmed into the sender's email application. The second and third alternative messages still originate at the sender's client. The original message of Shinomura '709 does not contain the alternative message routing information!

McDowell '583 teaches a re-routing server facility and service whereas if a first, older, or abandoned email address associated with an Internet Service Provider (ISP) is no longer in use, a customer may register with a re-route server and have email forwarded first to the re-route server and then to a different email address. McDowell '583 provides numerous embodiments for forwarding mail from an old Internet Service Provider (ISP) address to a re-router server and then to a new ISP, such as a .forward file embodiment, an email alias embodiment, a LDAP embodiment, and a SMTP embodiment. *See* McDowell '583 column 5, lines 1-16; column 6, lines 20-29; column 12, lines 24-49. McDowell '583 states that the SMTP wrapper embodiment could be implemented via software or via hardware and in the software embodiment, the SMTP wrapper is around an ISP's message transport system such as "sendmail" program that determines how the wrapped code is to be executed. Of particular interest in further elucidating the nature of the wrapper, McDowell '583 states that forwarding is directly by the old ISP, which forwards the message either to a re-route server or to the user's new account at a new ISP. Direct and indirect methods are further described in column 12 with respect to Figures 13, 13a and 13b. In all SMTP embodiments, at least one server has an SMTP table for holding new addresses for receiving email.

Thus, McDowell '583 uses either software or hardware tables in an ISP's server. Again, the original email message does not contain the rerouting information, i.e., the SMTP extended parameters; in McDowell '583 tables exist in the ISP servers with the rerouting information.

Applicant maintains that the combination of Shinomura '709 with McDowell '583 do not provide the claimed (as amended) invention of an email message that is self-rerouting because it's the SMTP protocol of the email message itself that is extended with alternative recipient parameters. *Neither McDowell '583 nor Shinomura '709 suggest an extension to the SMTP protocol of the email message itself, as claimed by Applicant.* Proposing SMTP lookup tables in ISP servers, as in McDowell '583, does not modify the SMTP protocol of the email message. As discussed in earlier responses, Shinomura '709 does not teach specifying an alternative recipient in the SMTP protocol and now, upon closer examination of McDowell' 583, neither does this reference! Moreover, neither reference suggests that the modification can be put into the email message itself to make the email message self-rerouting. Applicants respectfully request the Examiner to withdraw the rejection of claims 1, 2, 4 9-12 and 17-20 under 35 U.S.C. §103(a).

The Rejection of claims 5-8, 13-16 and 21-24 under 35 U.S.C. §103(a)

The Examiner rejects claims 5-8, 13-16 and 21-24 under 35 U.S.C. §103(a) employing a combination of Shinomura '709, McDowell '583, and Buckley '809. As above, the Examiner admits that Shinomura '709 does not teach notification to the user of an email system of successful delivery to alternate recipients. The Examiner, however, asserts that McDowell' 583 teaches a SMTP software implementation, and Buckley '809 teaches the preservation of delivery status notification (DSN) and some additional DSN options.

Shinomura '709 is discussed as above and teaches a way for a user to enter email addresses of different receiving terminals for the same recipient into an email address program, and then through a modification of the email application program

interface, if delivery was not successful within a period of time, the email would be resent from the originator to a different email address in the address book. McDowell '583 provides either software or hardware SMTP tables in the ISP servers having the new email address information. Buckley '809 preserves original delivery status notification information and translates the delivery status notification information into the closest option supported by the receiving network. Buckley '809 provides the example of translating delivery status notifications from an SMTP network to an X.400 network, *see* column 3, lines 22-47.

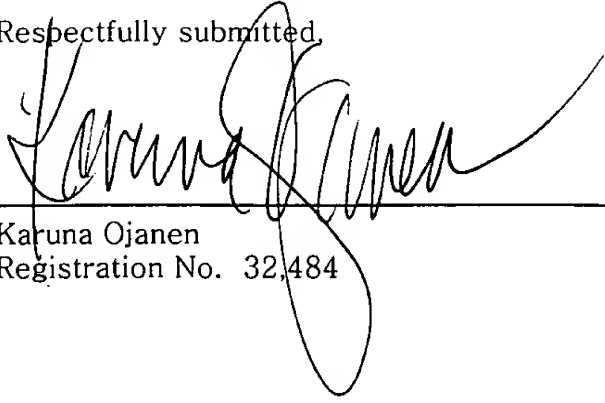
Indeed, Buckley '809 could be combined with Shinomura '709 and McDowell '583 but the combination would still not yield Applicant's claimed invention because *Shinomura '709 and McDowell '583 still do NOT teach an alternate recipient extension to the SMTP protocol within the email message itself as in the amended claims. Buckley '809, moreover, also does NOT teach the claimed ARCPT extension of the SMTP protocol, nor the ALTERNATE delivery status notification in the self-rerouting email message.* Buckley '809 would merely translate the novel and nonobvious extensions and keywords of the SMTP protocol claimed by the Applicant into another network protocol which could possibly be used by one of the different receiving terminals as described by Shinomura '709. Thus, Applicant respectfully requests the Examiner to withdraw the rejection of claims 5-8, 13-15 and 21, 22, and 24 under 35 U.S.C. §103(a).

CONCLUSION

In summary, Shinomura '709 does not teach extended alternate recipient SMTP extensions within the email message that makes the email message a self-rerouting one. McDowell '583 does not teach extended alternate recipient SMTP extensions within the email message that makes the email message a self-rerouting email message. Buckley '809 does not teach extended alternate recipient SMTP extensions within the email message but instead tells us how to translate all these extensions, delivery status notifications, etc. among the different email protocols and networks. If none of the references suggest or teach the extended alternate recipient SMTP extension within the email message to create a self-rerouting email message, how can their combination possibly teach or suggest the claimed invention? In contrast. Applicant's claimed invention is quite compelling in its simplicity and coordination with the SMTP protocol when contrasted with different receiving terminals, different and abandoned ISPs, and different networks of the referenced patents. Thus, Applicant respectfully requests the Examiner to review the amendments and the remarks and enter the proposed amendments because they merely incorporate dependent claims into independent and intervening claims and to pass the application to issuance. The Examiner is further invited to telephone the Attorney listed below if he thinks it would expedite the prosecution and the issuance of the patent.

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Respectfully submitted,



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